

REMARKS

With entry of this amendment, claims 1-19 and 26-32 are pending in this application. Claims 1-19 and 26-27 stand rejected, claims 20-26 have been cancelled, and claims 28-32 have been added. Based on the foregoing amendments and following remarks, reconsideration and allowance of this application is respectfully requested.

Drawing Objections

Figure 3 stands objected to for illustrating reference numbers that do not point to any particular features. Figure 3 has accordingly been amended to more clearly point to the features with the reference numbers. As such, Applicant respectfully requests withdrawal of the drawing objections.

Claim Rejections-35 U.S.C. §103

Claims 1-19 and 26-32 stand rejected under 35 U.S.C. §103, as being obvious over U.S. Patent No. 6,308,148 (“Bruins”) in view of U.S. Patent No. 6,587,878 (“Merriam”). Applicant respectfully traverses this rejection, since neither Bruins and Merriam, alone or in combination, disclose, teach, or suggest the combination of elements required by these claims. As an initial matter, Applicant does not acquiesce that Bruins and Merriam constitute §102(e) prior art and reserves the right to antedate these references should it become necessary. Also, various amendments have been made to the claims to either make them more readable or to more clearly define what Applicant regards as the invention. Applicant emphasizes that none of these amendments narrow the claims and have not been made to overcome any current or future rejection.

Turning to the Examiner’s prior art rejection, Applicant believes that the Examiner has improperly combined the teachings of Bruins and Merriam. As the Examiner surely knows, there

must be a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings. (See M.P.E.P. §2143). In determining whether such suggestion or motivation exists in the prior art, the Examiner cannot benefit from impermissible hindsight vision afforded by the claimed invention. In particular:

Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. (M.P.E.P. §2142).

In concluding that it would have been obvious to combine the Bruins' method of extracting packet information from filtered flow records with Merriam's performance measurement program to measure actual performance data extracted from the filter, the Examiner merely stated that Bruins would want to make this combination "because Bruins would want to use Merriam's performance measurement result to adjust the parameters of the network to make the network perform more efficiently," citing the next to the last sentence of the Abstract of Bruins as motivation. (See paragraph bridging pages 3-4 of the Office Action). However, this sentence only conveys the obvious, i.e., that flow data can be examined to improve the efficiency of the network. In fact, there is no suggestion anywhere in Bruins or Merriam that network efficiency could somehow be improved by performing active measurements of target sites in the network based on information contained within flow records.

Bruins is focused on providing an improved system for analyzing large amounts of data packet flow data, whereas Merriam is focused on providing an improved system for performing active tests on network devices. There is no suggestion in Bruins or Merriam to provide a system

that performs both of these functions, and there is definitely no suggestion to somehow tie these two functions together.

In contrast, the present inventor has developed a solution to more efficiently perform active measurements on network targets by correlating the active measurements with the actual flow of data packets through the network. Any suggestion to make this correlation can only be found from a reading of the instant application, which the Examiner cannot consider, as discussed above.

Thus, Applicant submits that independent claims 1, 10, and 19, as well as the claims depending therefrom (claims 2-9, 11-19, and 26-27) are not obvious over the combination of Bruins and Merriam, and as such, respectfully request withdrawal of the §103 claim rejections.


New Claims

Applicant submits that newly added claims 28-32, which depend from independent claims 1, 10, and 19, are supported by the specification, as originally filed, and are patentable over the prior art at least for the same reasons as the independent claims.

Conclusion

Based on the foregoing, it is believed that all claims are now allowable and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at (714) 830-0600.

Respectfully submitted,


Michael J. Bolan
Reg. No. 42,339

Dated: September 22, 2004

Bingham McCutchen LLP
Three Embarcadero Center, 18th Floor
San Francisco, California 94111

IN THE DRAWINGS

Please replace Figure 3 with the substitute Figure 3 shown in the marked up drawing sheet attached hereto.